

REMARKS

This Application has been carefully reviewed in light of the final Office Action mailed November 3, 2004. Claims 1, 3-10, 19 and 21-29 are pending in the Application. In the final Office Action, Claims 1, 3-10, 19, 21-24 and 26-29 were rejected and Claim 25 was objected to. For at least the reasons discussed below, Applicants respectfully request reconsideration and favorable action in this case.

Section 103 Rejections

The Examiner rejects Claims 1-9, 19, and 21 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,658,457 issued to Nishikawa et al. ("*Nishikawa*") in view of U.S. Patent No. 6,574,192 issued to Egnell ("*Egnell*").

Claim 1 of the present application recites the following:

A method for providing protection for connectionless signals in a telecommunications network comprising a plurality of nodes, the method comprising:

generating a first protection path for connectionless signals from each of the nodes to a destination node;

generating a second protection path for connectionless signals from each of the nodes to the destination node, the second protection path distinct from the first protection path; and

routing protection traffic along one of the protection paths to the destination node;

wherein generating the first protection path and generating the second protection path each comprise decomposing the telecommunications network.

Claim 19 recites similar, although not identical, limitations.

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. In the present case, a *prima facie* case of obviousness cannot be maintained at least because (even assuming for the sake of argument that the references did suggest or motivate a

combination of the references to a person of ordinary skill in the art at the time of the invention) *Nishikawa* and *Egnell*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, fail to disclose all of the elements of the pending claims.

For example, Claim 1 recites that the second protection path is distinct from the first protection path. For example, as described at page 10, lines 28-29 of the Application, the paths “are distinct in that they share no common nodes 14 or links.” For a teaching of this limitation, the Examiner cites to Column 6, lines 50-55 of *Nishikawa*. However, there is no teaching that the protection paths are distinct in this passage or anywhere else in the reference. For at least this reason, Claim 1 is allowable.

Furthermore, Claim 1 recites that “generating the first protection path and generating the second protection path each comprise decomposing the telecommunications network” For a teaching of this limitation, the Examiner cites to Figure 3A and to Column 5, line 3-7 and Column 2, lines 33-34 and 36-68 of *Egnell*. However, there is no teaching of the recited decomposition in this passage or anywhere else in the reference. *Egnell* simply teaches using one or more protection links (L) to route traffic between nodes (N) when a segment (S) of a ring connecting the nodes has a fault. The links that are used for this protection are simply the links that bypass the particular fault. There is no disclosure or suggestion of decomposing the network to generate first and second protection paths, as recited in Claim 1. Again, by way of example and without limitation, Applicants direct the Examiner's attention to the discussion of network decomposition in the present Application with reference to FIGURES 2 and 3 on pages 9-12 of the “Detailed Description of the Invention.” For at least this additional reason, Claim 1 is allowable.

Furthermore, Claim 19 contains limitations similar to those discussed above with reference to Claim 1. Therefore, for the reasons provided above, Applicants respectfully request reconsideration and allowance of Claims 1 and 19, as well as the claims that depend from these independent claims.

In addition to depending from an allowable independent claim, several of the dependent claims also include additional limitations not found in the cited reference. For example, and without limitation, Claims 4, 5, 6, 7, and 21 all recite details of the decomposition of the network recited in Claims 1 and 19. Claims 4 and 21 recite that decomposing the network comprises decomposing the network into a ring (recited in Claims 3 and 19) and into one or more ears. Claim 5 recites “charting the ring horizontally beginning with the destination node and ending with the destination node,” Claim 6 recites “ordering the ears and charting the ears horizontally based on the order of the ears,” and Claim 7 recites “generating the first protection path in a first direction based on the charted ring and ears and . . . generating the second protection path in a second direction based on the charted ring and ears.” For a supposed teaching of all of these limitations, the Examiner cites to the same passages that he cites to for Claim 1. As described above, that passage does not disclose or suggest decomposing a network. Furthermore, the passage clearly does not recite the further limitations of Claims 4, 5, 6, 7, and 21, and the Examiner makes no attempt to explain how any of these limitations are disclosed. For at least this additional reason, Applicants respectfully request reconsideration and allowance of Claims 4, 5, 6, 7, and 21.

Furthermore, the Examiner also rejects Claim 10 under 35 U.S.C. § 103(a) as being unpatentable over the combined system (*Nishikawa and Egnell*) in view of U.S. Patent No. 6,765,880 issued to Hillard (“*Hillard*”) and rejects Claims 22-24, and 26-29 under 35 U.S.C. § 103(a) as being unpatentable over the combined system (*Nishikawa and Egnell*) in view of U.S. Patent No. 6,473,397 issued to Au (“*Au*”). Claims 10, 22-24 and 26-29 depend from independent Claims 1 or 19 and are allowable at least because they include the limitations of either Claim 1 or Claim 19, both of which have been shown above to be in condition for allowance. For at least this reason, Applicants respectfully request reconsideration and allowance of Claims 10, 22-24 and 26-29.

Allowable Subject Matter

Applicants note with appreciation the Examiner's indication that Claim 25 would be allowable if rewritten in independent form. However, Claim 25 depends from independent Claim 19, which is in condition for allowance, as discussed above. Accordingly, Applicants have not amended Claim 25.

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953-6986.

Although no fees are believed to be due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants

A handwritten signature in black ink, appearing to read 'BW Oaks', is written over the printed name of the attorney.

Brian W. Oaks
Reg. No. 44,981

Date: December 27, 2004

Correspondence Address:

Customer Number

05073